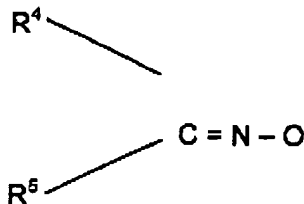


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32. A process according to claim 1, wherein the silicon-containing functional groups are curable by virtue of one or more oxime groups of the formula



in which R^4 and R^5 may be the same or different and each represents a straight-chain or branched, saturated or unsaturated, aliphatic hydrocarbon radical.

33. A process according to claim 9, wherein the proportion of siloxane repeating units in the film-forming polymer (A) is not more than 25%.

34. A substrate in a fouling environment and bearing a coating and a cured fouling-inhibiting layer thereon, formed by a process according to claim 1.

Response

No new matter is added by the amendment to claim 9 and support for the amendment can be found in the specification at page 11, lines 1-4. The additional claims 31-34, do not add any new matter and support for their addition can be found throughout the specification.

Applicants will respond to Examiner's remarks paragraph by paragraph.

1. Applicants will file the certified copy of the priority document when it becomes available.
2. No response is necessary.
3. Applicants respectfully disagree with the Examiner's assertion that the "preferably" and/or "more especially" and/or "especially" and/or "for example"

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claim language in claims 4,5,10 and 30 is indefinite under 35 U.S.C. 112, second paragraph. One skilled in the art would understand these terms in the claims and would not read them as limitations as to the scope of the claims, especially when read in light of the specification.

Claim 9 has been amended to remove any inconsistencies and not for matters of patentability.

4. No response is necessary.

5. The Examiner rejects claim 30 as allegedly anticipated under 35 U.S.C. § 102 (b) as being anticipated by WO 93/13179. Applicants respectfully traverse this objection.

Contrary to the Examiner's assertions, the procedure of WO 93/13179 results in a single coating layer in which the outermost surface region is rich in (B), whereas the innermost region is rich in (A). Before curing, (A) gravitated towards the substrate and (B) gravitated towards the outer surface of the coating layer. This indicates that a diffusion pattern is present throughout the cured single coating layer. Thus, component (B) is present throughout the whole coating layer.

In the process of the present invention, component (A) is first applied to the substrate. Next, component (B) is applied on top of component (A) and bonded to layer (A) by a condensation reaction. This reaction takes place at the interface between component (A) and component (B). Component (B) will not gravitate through component (A) towards the substrate.

Thus, the process of the present application results in two layers, a coating layer comprising (A) and an fouling-inhibiting layer comprising (B), which are connected to each other through condensation reaction at the interface. WO 93/13179 on the other hand, results in a single coating layer. It is evident from WO 93/13179 that component (B) has a tendency to gravitate

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towards the outer surface. Consequently, claim 30 is not anticipated by WO 93/13179.

6. The Examiner has rejected claims 1-4, 6-14, 16-21, 25-30 under 35 U.S.C. § 102 (b) as being allegedly anticipated by U.S. Patent No. 4,637,958 to Wegehaupt et al. Applicants respectfully traverse this objection. As a first matter, for a rejection to be sustained under §102(b) each and every element of the claimed invention must be disclosed in the cited prior art reference. It is respectfully submitted that the cited reference fails to disclose at least the following features and elements of the present invention as noted herein.

In Wegehaupt, amine functionalities are present in the primer layer, see column 2, lines 40-44. For example, the first layer applied in examples 1 and 2 comprises N- β -aminoethyl- γ -aminopropyltriethoxysilane. These amine functionalities will interfere with the silicon-containing groups in the primer. As a consequence, when such a first layer has been applied, it does not comprise latent reactive silicon-containing functional groups as required by the claims of the present invention. When the second layer comprising an organopolysiloxane is applied and cured, the crosslinking will only take place in the organopolysiloxane. Thus, both the process and the resulting product is different than that obtained by the process of the present application.

The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. *Connell v. Sears, Roebuck & co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

Consequently, claims 1-4, 6-14, 16-21, 25-30 are not anticipated by Wegehaupt for at least the reasons set forth above.

7. No response is necessary.

8. Finally, the Examiner has rejected claims 1-29 under 35 U.S.C. § 103 (a) as allegedly being obvious over WO 93/13179 alone or over WO 93/13179 in view of Wegehaupt. Applicants respectfully traverse this rejection.

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Contrary to the Examiner's assertions, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *Carela v. Starlight Archery*, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

Nowhere in the entire office action has the Examiner provided one scintilla of evidence that there is a motivation to combine any of the references cited, as required by the MPEP section 2143.01. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. *Carela v. Starlight Archery*, 231 U.S.P.Q. 644 (Fed. Cir. 1986). See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found th claimed invention to have been obvious in light of th

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teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The prior art relied upon by the Examiner coupled with the knowledge generally available in the art at the time of the invention (rather than as impermissible 20/20 hindsight), must contain some suggestion or incentive that would have motivated the skilled artisan to modify the reference or to combine the references. See *In re Fine*, 837 F. 2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Certainly in the present case, such motivation was not present. There is absolutely no motivation to look to the cited prior art (and more particularly to combine such prior art) for the **PROBLEM OF A FOULING** with respect to a coating composition in which the coating is non-toxic, adheres well and is not weak and liable to damage.

For a rejection under 35 U.S.C. 103 to be sustained, the differences between the features of the reference and the present invention must be obvious to one skilled in the art. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the Applicants' specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide Manufacturing Co.*, 226 U.S.P.Q. 438, 440 (PTO Bd. App. 1984).

Achieving unexpected results by going in a direction different from that taught by others provided objective evidence of non-obviousness. *Specialty Composites v. Cabot Corp.*, 6 USPQ2d 1601 (Fed. Cir. 1988). In the present invention, the Applicants' utilize a separate two layer coating process rather than the conventional/popular two component system in which the components are mixed prior to application to the substrate.

Contrary to the Examiner's unsupported statements, there is no suggestion or indication in WO 93/13179 that component (A) and component (B) could be applied without mixing. WO 93/13179 describes a coating composition comprising component (A) and (B), which is thus a mixture of component (A) and (B). In general, a coating composition is packed as a two-

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pack system when it concerns a reactive system. Shortly before application of the coating, the contents of both packs are mixed. Applicants request the scientific basis for the Examiner's contention that such a two pack system could be applied as separate layers to a substrate without serious consequences to the characteristics of that two pack system.

There is absolutely no basis for the Examiners' contention that such a two pack system would render a process utilizing two separate layers obvious. More to the point one skilled in the art looking at the question of using multiple layers to attain an antifouling on a substrate would not look to a classic two component system which is premixed before application! Such systems among other differences utilize distinct reactivity mechanisms. See also paragraph 5 above, which even though directed to the question of anticipation is also applicable in this instance with respect to the question of obviousness.

At page 6 of the Office Action, the Examiner states that "[s]ince WO'179 teaches that the components react, however they still separate somewhat ...one of ordinary skill in the art would have been motivated to apply components (A) and (B) as separate layers in order to prevent premature crosslinking of the components, therefore making application difficult or impossible." Applicants assert that this is an erroneous statement of the art relating to two pack systems and the disclosures of the prior art. Applicants request support for this assumption.

Furthermore, as discussed above, the process of the present application results in product that is different from the product obtained by the process of WO 93/13179.

Additionally, combining the teaching of Wegehaupt with the teaching of WO 93/13179 would still not result in a product as obtained by the process of the present invention because there is no mention and certainly no motivation whatsoever in either document for one skilled in the art to apply a first layer

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carrying unreacted silicon-containing functional groups providing latent reactivity.

Consequently, claims 1-29 involve an inventive step over WO 93/13179. For at least the reasons set forth above, the Examiner is requested to withdraw her objection to claims 1-29.

10. The Examiner also alleges that claims 15 and 24 are obvious under 35 U.S.C. § 103 (a) over Wegehaupt. The Examiner puts forth the erroneous allegation that it would have been obvious for one of ordinary skill in the art to determine that molecular weight. Notwithstanding the fact that the Applicants traverse the Examiner's statement that determining molecular weight is obvious, the Examiner has completely failed to provide any suggestion or motivation for one of ordinary skill in the art to look to Wegehaupt for the question of molecular weight. Additionally, for at least the reasons set forth above and since claims 15 and 24 are dependent on claim 1, which is novel and involves an inventive step, claims 15 and 24 are non-obvious.

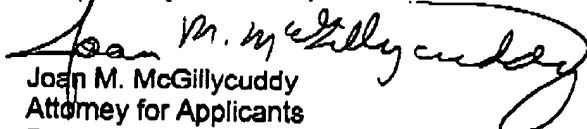
11. No response necessary.

12. No response necessary.

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In view of the amendments and remarks herein and the papers submitted previously, Applicants respectfully request reconsideration and withdrawal of the subject rejections. The present application is believed to be in condition for allowance, which action is respectfully requested.

Respectfully submitted,


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MARKED UP VERSION OF CLAIM 9**Serial N . 09/599,174**

9. A process according to claim 1, wherein at least [a major proportion] 55% of the repeating units in the film-forming polymer (A) are other than siloxane repeating units.